

REMARKS

Claims 17-36 are hereby withdrawn from consideration. Applicant reserves the right to pursue these claims in a continuation application.

No other amendments are made to the claims. Accordingly, reconsideration of the pending claims would not require an additional search.

The Examiner has rejected apparatus claims 15-19 and 21-26 under 35 USC 103(a) as being unpatentable over AAPA (Applicant's admitted prior art) including Lenz et al (5,534,751 in view of Arai (JP 11214487). Applicant respectfully traverses based on the reasons discussed below.

The Office Action (page 3) suggested that "AAPA as modified by the teaching of Yasushi Arai would allow some one to lift the rings placed on the stepped hanger attached to the top ring with lock bore, pass the larger hole of the bore through the hanger adapter and twist for a small angle of let the plunger of the hanger adapter move to the smaller hole to lock it in place."

Even if that were the case, for the operation to be achievable, the locking bore must be radially offset (i.e., on a different radius or occupy a different angular position around the top ring) in the manner claimed in claim 15 from the stepper hanger (as recited in claim 15 and as can be seen in Fig. 2 wherein the stepper hanger 235 is radially offset from bore 205).

The Examiner also agrees with this, since the Examiner stated on page 4 of the Office Action "Another reason why this could not be allowable, is the fact that in order to apply the teaching of Yasushi Arai, the stepped hanger would **have to be** installed offset since, as can be best seen in Fig. 2 of specification, installing stepped hanger (235) in line with the locking bore (205) **would not make it work.**" (Underline and bold emphasis added).

Applicant completely agrees that the offset feature is critical in the context of the invention of claim 15.

Since Applicant and the Examiner both agree that the offset feature is a feature that is critical to make the invention work, it is logical then that this offsetting is NOT merely a rearrangement of parts. In fact, without this offsetting, the arrangement is not functional, as mentioned by the Examiner.

In re Japikse (86 USPQ 70, CCPA 1950) was cited by the Examiner to support the position that mere rearrangement of parts do not make a claim patentable. While this is true, In re Japiske is not applicable to the current situation.

Applicant wishes to direct the Examiner's attention to MPEP section 2144.04, the MPEP section that cites In re Japiske as a potential source of supporting rationale for obviousness rejections under 35 USC 103.

MPEP 2114.04 cautions in its opening paragraph "If the applicant has demonstrated the criticality of a specific limitation, it would **NOT** be appropriate to rely solely on case law as the rationale to support an obviousness rejection." (Emphasis added).

As discussed, the offset limitation is critical, as agreed by the Examiner. Accordingly, ignoring the criticality of this offsetting feature and using In Re Japiske to reject claim 15 based on the rearrangement-of-part rationale is not appropriate, according to MPEP 2144.04.

Further, MPEP 2144.04(VI)(C) discusses the rearrangement of parts rejection and In Re Japiske.

"In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). However, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)."

The rearrangement of the position of the starting switch in In re Japiske “would not have modified the operation of the device.” In contrast, as the Examiner admitted, without the offsetting feature, the instant arrangement would not work. Accordingly, the instant invention is different from the situation in In re Japiske and more closely resemble the situation described in the opening paragraph of MPEP 2144.04 in which it is pointed out that using legal precedent without regard to criticality is not appropriate. In re Japiske is clearly inapplicable in this instant.

As further pointed out in MPEP 2144.04(VI)(C), Ex parte Chicago Rawhide Mfg., Co. pointed out that “The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, **without the benefit of appellant’s specification**, to make the necessary changes in the reference device.” (emphasis added).

Applicant respectfully submits that Ex parte Chicago Rawhide Mfg., Co. is the controlling law in this case. Applicant respectfully submits that neither AAPA, Arai, nor Lenz suggests or teaches this critical offset feature. In fact, this critical feature, in the manner claimed in the combination of claim 15, is not available to the worker in the art without the benefit of appellant’s specification. If the Examiner found a particular suggestion to offset the stepper hanger apart from the locking bore, in the manner recited in the combination of claim 15, Applicant would greatly appreciate the Examiner specifically points out where that suggestion can be found in the references.

In summary, since the offset feature is critical in the manner claimed in the combination of claim 15 (as admitted by the Examiner) and since MPEP 2144.04 clearly points out that In re Japikse is not appropriate to apply in this instant (due to the fact that the offset feature is critical, i.e., offsetting does affect the operation of the device, and due to the fact that the prior art does not suggest the worker in the art, **without the benefit of appellant’s specification**, to make the offset feature change in the reference device(s), the Examiner’s rejections based on In re Japiske are respectfully traversed.

It is submitted that independent claims 15 is novel, nonobvious, and patentable. It is further submitted that the claims that depend therefrom, in addition to being patentable due to

Amendment submitted in response
to Office Action mailed 10/07/2004
U.S. Pat App. No. 09/916,784
March 7, 2005
Page 8

their dependence from the patentable parent claims, also recite other patentable features.
Accordingly, the allowance of these claims is also respectfully requested.

Conclusion

In view of the discussion herein, Applicant believes that all pending claims are allowable.
Should the Examiner believe that a telephone conference would expedite the prosecution of this
application, the undersigned can be reached at 408-257-5500.

Respectfully submitted,

/Joseph A. Nguyen/
Joseph A. Nguyen
Reg. No. 37899